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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,496	02/15/2002	Ross Tsugita	1001.1422103	5372
28075	7590	02/07/2005	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			BUI, VY Q	
		ART UNIT	PAPER NUMBER	
		3731		
DATE MAILED: 02/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/077,496	TSUGITA ET AL.	
	Examiner Vy Q. Bui	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 38-49, 51 and 52 is/are pending in the application.
  - 4a) Of the above claim(s) 42 and 44 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 38-41, 43, 45-49, 51-52 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 38-41, 43, 45-49 and 51-52 are rejected under 35 U.S.C. 102(b) as being anticipated by GELBFISH (5,800,457).

As to claims 38-41, 43, 45 and 47-48, GELBFISH (Figs. 1-3D) discloses self-expandable filter 12 having finger 46 extending distally from distal sleeve 18 of filter 12 and guidewire 42 having a stop proximal to the distal end of guidewire 42 and sheath 26 for delivering filter 12 as recited in the claims. As to claims 51 and 52, because filter 12/46 including sleeve 18 allowing guidewire 42 going through, therefore, Gelbfish device is structurally capable of performing in a manner where filter 12/46/18 can be slidably disposed along guidewire 42 such that guidewire 42 extends both distally and proximally of filter 12/16/18 as recited in the claims.

Notice that the distal end portion/sleeve 18 of filter 12 is capable of being slid along guidewire 42 over stop/hook/stop-receiving member 44 from a first position proximal to the stop to a second position distal to the stop 44 as indicated in the following reproduced drawing 3C:

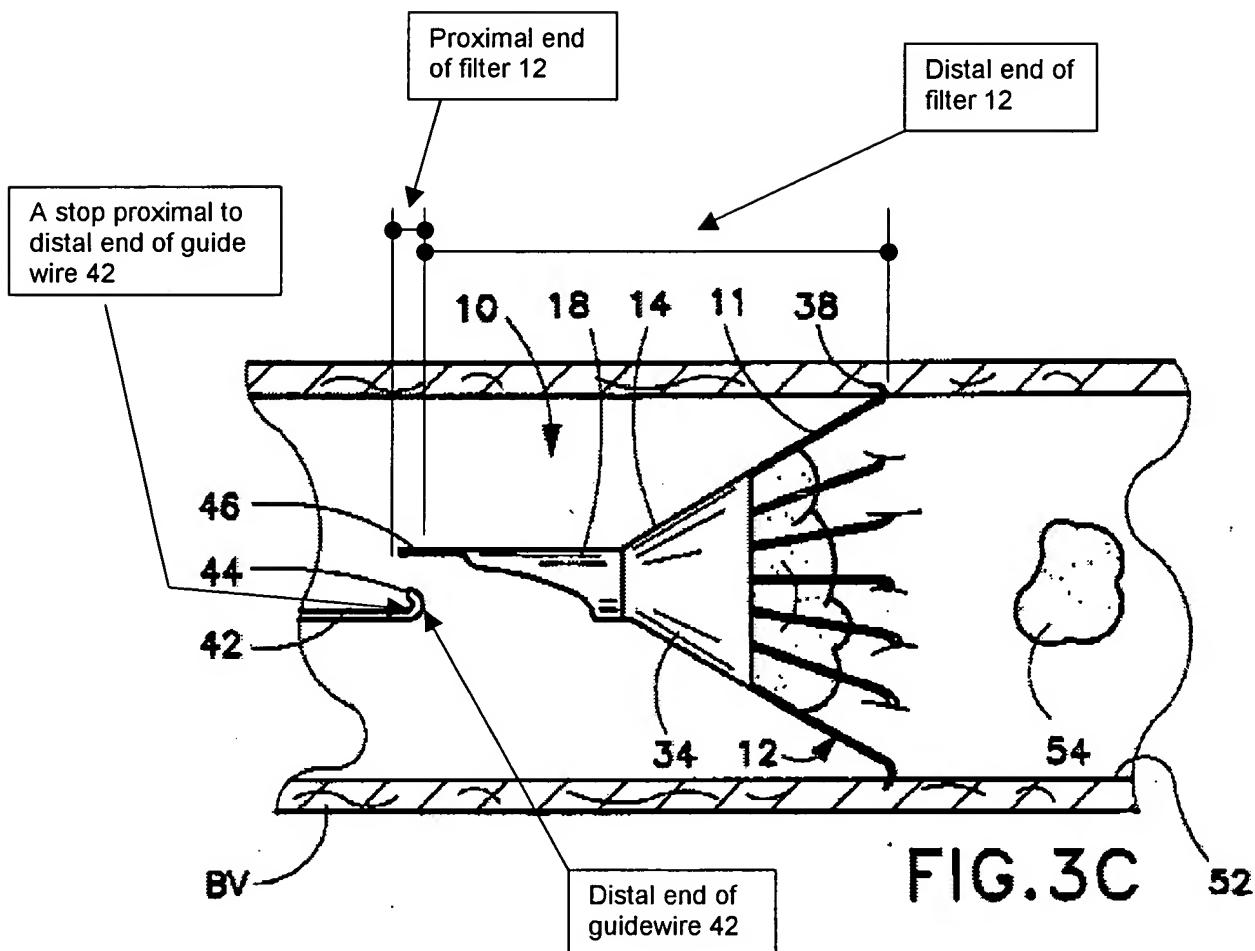


FIG. 3C

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2. Claim 46 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GELBFISH (5,800,457).

As to claim 46, GELBFISH discloses stop/hook 44 defining a first diameter, distal end portion of filter 12 defining a diameter larger than the first diameter, and the proximal end/finger 46 of filter 12 defining a diameter smaller than the first diameter. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to configure GELBFISH device as recited in the claim, for this would be one obvious choice of design.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49 is rejected under 35 U.S.C. 103(a) as being obvious over GELBFISH (5,800,457).

GELBFISH discloses substantially all structural limitations as recited in the claim, except for the stop including first and second tubular members. It would have been obvious to one of ordinary skill in the art at the time of the invention to configure GELBFISH device as recited in the claim, for this would be one obvious choice of design.

***Response to Arguments***

Applicant's arguments filed 11/24/2004 have been fully considered but they are not persuasive.

The Applicants mainly argued that:

1. In particular, independent claims 38 and 39 each requires that the filter is "slidably disposed along the guidewire (emphasis added)". One of ordinary skill in the art, having read the originally filed specification and claims, and having viewed the originally filed Figures, would understand that Gelbfish does not disclose a guidewire (Remarks: page 6 of 9, paragraph 3).

2. Further; with respect to claim 39, the claim requires that the filter be configured so that the distal end of the filter advances over the stop while the proximal end of the filter is configured to be retained by the stop. This is another feature not shown by Gelbfish. It does not appear that filter 12 itself includes any structure that is configured to be retained by a stop (again, if hook 44 can be considered to be a stop). Gelbfish discloses element 18 (described as a coupling element) and element 46 (described as a finger that can apparently interact with hook 44. Elements 18 and 46 are not believed to constitute part of filter 12 and thus cannot be considered as disclosing the claimed feature discussed herein.

The Examiner would like to respond as follows:

As shown in Figures 3a-3c, for example, it is reasonable for one of ordinary skill in the art to recognize Gelbfish' filter 12 having different elements such as prongs/tines 11, access port/sleeve 18 and finger 46. As such, one can recognize distal end of filter 12 is also distal end of finger 46. Further, wire 42 having hook/stop 44 at the distal end can be reasonable considered as a guidewire because finger 46/filter 12 can be guided or slidably disposed along

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at least a portion of guidewire 42 and retained by hook/stop 44 as recited by the claims. Further more, at least when the proximal and distal ends of the filter 12/46 are specified as shown in Fig. 3C reproduced above, it is clearly that Gelbfish device is capable of performing in a manner as recited in the claims. Notice that there is no specific limitation in the claim to clearly define the boundary between the distal end and the proximal end of the filter 12/46.

For the above reasons, the claimed invention is not clearly structurally defined over Gelbfish-'457 and therefor is unpatentable over Gelbfish-'457.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

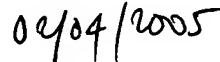
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  


Vy Q. Bui  
Primary Examiner  
Art Unit 3731